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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,441	11/04/2005	Stefano Fumagalli	LSP-1010US	2411
24923	7590	10/02/2008		
PAUL S MADAN MADAN, MOSSMAN & SRIRAM, PC 2603 AUGUSTA DRIVE, SUITE 700 HOUSTON, TX 77057-5662			EXAMINER YOON, TAE H	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			10/02/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/519,441	Applicant(s) FUMAGALLI ET AL.	
	Examiner Tae H. Yoon	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-36 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 17-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/1/07</u> . | 6) <input type="checkbox"/> Other: ____. |

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 439 363 in view of Bundy et al (US 5,085,707) and Malhotra et al (US 5,897,961)

EP teaches a paper coating composition comprising a binder, pigment or filler and desizing agent at col. 8, lines 24-34 wherein ratios of components are also taught. Said ratios would yield 0.01-20 parts by weight of a binder, 0.02-1 parts by weight of desizing agent and 0.01-1 100 parts by weight of filler or pigment. Said desizing agent includes various derivatives of sulfosuccinic acid such as ethoxylated alcohol sulfosuccinate (Alkasurf SS-DA4-HE) which meet the instant substance inherently and salt of dioctylsulfosuccinate (col. 13, lines 54-59). Or, other fatty alcohol derivatives are taught at col. 14, lines 25-30, and thus use of a fatty alcohol in said ethoxylated alcohol sulfosuccinate (Alkasurf SS-DA4-HE) would be obvious modification

Acrylic binders are taught at col. 11. A coating thickness 0.2 to 20 microns taught at col. 8, lines 41-43 would meet the instant claims 29 and 30.

The instant invention further recites a dispersant, calcium stearate, moles of oxide in said ethoxylated alcohol sulfosuccinate, dioctylsulfosuccinate and pigment size of finer than 2 microns over EP.

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Bundy et al teach employing a dispersant to pigmented slurry at col. 4, lines 48-62 and pigment (kaolin) size of less than 2 microns at col. 3, lines 29-53. Bundy et al also teach employing calcium stearate in a coating composition at col. 6, lines 56 and 62

Malhotra et al teach monoester sulfosuccinates and diester sulfosuccinates at col. 22, lines 17-18. . Thus, use of an ester form such as dioctylsulfosuccinate in EP would be obvious modification of salt of dioctylsulfosuccinate since such esters are known as taught by Malhotra et al.

Thus, it would have been obvious to one skilled in the art at the time of invention to utilize art well known pigmented coating additives such as a dispersant and calcium stearate and pigment size of less than 2 microns of Bundy et al in EP since use of such in a paper coating composition is well known as taught by Bundy et al and since EP teaches a coating thickness of 0.2 micron which would require pigment/filler having a particle size of 0.2 micron or less in order to obtain a smooth coated surface, and further to employ monoester sulfosuccinates or diester sulfosuccinates such as dioctylsulfosuccinate of Malhotra et al in EP and Bundy et al thereof since EP teaches salt of dioctylsulfosuccinate and thus use of an ester form of sulfosuccinate would be expected to yield sme or similar results since EP teaches use of other ester form (ethoxylated alcohol sulfosuccinate) and since use of esters in a paper coating is well known as taught by Malhotra et al and the ethoxylated alcohol sulfosuccinate of EP would encompass various moles of oxide absent showing otherwise.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tae H Yoon
Primary Examiner
Art Unit 1796

THY/September 27, 2008

/Tae H Yoon/